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Filing date: **05/23/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057757
Party	Plaintiff Avalanche, LLC
Correspondence Address	URY FISCHER LOTT & FISCHER PL PO DRAWER 141098 CORAL GABLES, FL 33114-1098 UNITED STATES UFischer@lottfischer.com, SDLott@lottfischer.com
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Signature	/Ury Fischer/
Date	05/23/2014
Attachments	[FINAL] 05.23.14 - Remarks in reply to show cause response - JEW-CY.pdf(325668 bytes ) EXHIBIT A to Remarks - LTR of Protest Memo.pdf(34966 bytes ) EXHIBIT B to Remarks - Notice of Opposition.pdf(296376 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Avalanche, LLC**, a Florida limited liability company,  
Petitioner,

v.

**Jewcy Media, LLC**, a Delaware limited liability company,  
Registrant.

Cancellation No.: 92057757

Registration No. 3,228,371

Issued: April 10, 2007

Mark: **JEWCY**

**PETITIONER'S REMARKS IN CONNECTION WITH  
REGISTRANT'S RESPONSE TO ORDER TO SHOW CAUSE**

Petitioner, Avalanche, LLC, through undersigned's counsel, states the following in reply to Registrant's response to the Board's March 27, 2014 Order to Show Cause (hereinafter "Response"):

**A. Introduction**

On March 27, 2014, the Board ordered Registrant to show cause why the present proceeding should not be concluded with a judgment of abandonment against Registrant due to Registrant's failure to file a Section 8 affidavit in support of its registration. The Order to Show Cause clearly advised Registrant that the only way to avoid a judgment of abandonment was to provide evidence that the failure to file the Section 8 affidavit was the result of inadvertence or mistake. Instead of providing even a scintilla of the evidence requested by the Board, Registrant launched an attack on Petitioner, accusing Petitioner of bad faith in the filing of this cancellation proceeding. The Board entered an order on April 24, 2014 allowing Petitioner to reply to Registrant's response. Given the uncalled-for and unfounded nature of Registrant's attack on Petitioner, Petitioner hereby

files the instant remarks in reply to Registrant's Response to the Show Cause Order. It is Petitioner's intent to ensure that the Board be fully informed on all pertinent aspects before it reaches a decision in this matter.

**B. Registrant's Allegations of Bad Faith by Petitioner Are Unfounded and Unsupported by Any Evidence**

In the Response, Registrant alleges that the instant cancellation proceeding was filed in bad faith as it was purportedly "motivated by nothing other than a desire to obtain a judgment simply to have one," and was timed so as to prevent the registration in question to "naturally expire." These allegations of bad faith are preposterous and based on nothing but Registrant's wild imagination and disingenuous supposition.

As Registrant is fully aware, the subject Registration was cited against Petitioner's own application for registration of the mark **JEWCIER** (Serial Number 76/711,757) well before the filing of the instant petition for cancellation. As alleged in the Petition for Cancellation, and as has been confirmed by the declaration filed as part of the Response, Petitioner believed that the instant registration had been abandoned and therefore should not act as a bar to the registration of the **JEWCIER** mark. Accordingly, Petitioner was required to seek cancellation of the present registration in order to clear the way for its own registration. That goal, and nothing else, has been Petitioner's sole motivation in petitioning to cancel Registrant's mark.

The office action in which the present registration was cited against the **JEWCIER** mark was issued on February 28, 2013. A response to the office action was therefore due on August 28, 2013. Because Petitioner needed the Examiner to be aware of Petitioner's intent to seek cancellation of the present registration, Petitioner had to file the present

petition to cancel prior to the August 28, 2013 deadline. The instant petition to cancel was therefore filed on August 26, 2013. A response to the office action was then filed the next day notifying the Examiner that a petition to cancel had been filed. Therefore, contrary to Registrant's reckless allegations in the Response, there was no nefarious motive in the timing of the filing of the present petition for cancellation.

**C. Registrant Has Demonstrably Acted in Bad Faith in Connection with the Instant Registration**

If there has been any bad faith in these proceedings, it is entirely attributable to Registrant. Registrant has been demonstrably untruthful in its dealings with Petitioner, the Board and the examiner of Petitioner's application for the **JEWCIER** mark.

First, with respect to these proceedings, in paragraph 8 of the Petition to Cancel [Dkt. #1] Petitioner alleged as follows:

Upon information and belief, Registrant does not use the **JEWCY** mark in U.S. interstate commerce in connection with "dating and matchmaking services" in International Class 45.

On October 7, 2013, Registrant responded to this allegation with the following statement (See Answer [Dkt. #5] at paragraph 8) (emphasis added):

Registrant lacks knowledge as to Petitioner's information and belief, but otherwise avers that Paragraph 8 sets forth legal conclusions, to which no response is required, as to Registrant's use of the mark JEWCY. To the extent any response is required as to any allegations of Paragraph 8, such allegations are denied.

However, Registrant clearly knew that it was not using the JEWCY mark in interstate commerce in connection with the stated services, both at the time the allegation was made by Applicant, and at the time the Answer was filed. In fact, Registrant clearly admits as much in its Response and in the declaration filed in support of same (See

Response [Dkt. #7] at p. 2, and Oxfeld Declaration of [Dkt. #7] at paragraphs 2, 3)  
(emphasis added):

Jewcy made a business decision not to file a § 8 Declaration against the ‘371 Registration because it was not at the time making commercial use of the JEWCY trademark in connection with the Registered Services.

\* \* \*

Respondent did not file a sixth-year Declaration of Use (“Declaration”) in support of its Reg. No. 3,228,371 (the “‘371 Registration”) for JEWCY, the subject of Cancellation Proceeding No. 92057757, currently pending before the Trademark Trial & Appeal Board (the “Board”).

Respondent’s non-filing of a Declaration by the required deadline was a result of the mere fact that Respondent was not at the time making commercial use of the JEWCY trademark in connection with “dating and matchmaking services.” the services identified in the ‘371 Registration.

Second, with full knowledge that it had not made use in commerce to support the present registration, Registrant nonetheless purposely interposed the registration as an obstacle to Petitioner’s application to register **JEWCIER**. Specifically, Registrant filed a letter of protest in connection with Petitioner’s application for **JEWCIER** in which it alleged that the instant registration should act as a bar to Petitioner’s registration of **JEWCIER** for dating services. (See Exhibit “A” hereto). The letter of protest resulted directly in the issuance of the office action that forced Petitioner to commence the instant proceeding<sup>1</sup>. Despite Registrant’s knowledge that it has not used the present mark in commerce in connection with dating services dating back to at least April 10, 2013, but likely several years before that, Registrant chose to remain silent and leave Petitioner to “twist in the wind” with respect to both its application for **JEWCIER** and the present proceeding.

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<sup>1</sup> Petitioner’s application for JEWCIER had been noticed for publication prior to Registrant’s filing of its letter of protest.

As if the filing of a letter of protest asserting a mark it knew was not in use in commerce was not enough, Registrant also commenced Opposition Proceeding No. 91210294 against Petitioner's **JEWCIER** application based on the same registration. (See Exhibit "B" hereto). On March 30, 2013, just 10 days before Registrant now admits it was not using the subject mark in commerce, Registrant alleged that the subject registration was "valid and in full force and effect, and this constitutes prima facie evidence of [Registrant's] exclusive right to use the JEWCY Mark in commerce in connection with the goods and services specified in the [present registration]." (See Exhibit "B" at paragraph 1.)

Thus, Registrant has repeatedly demonstrated its willingness and ability to utilize the present registration as a bludgeon, even though it knows it is anything but "in full force and effect" and that the underlying trademark has not been in use for more than a year. At the same time, Registrant has the temerity to suggest that it is Petitioner who has acted in bad faith by petitioning to cancel when it did. Clearly, only a judgment declaring the instant mark abandoned will be sufficient to stop Registrant's abuse.

**D. Registrant Has Not Shown Good and Sufficient Cause Why Judgment Should Not Be Entered Against It**

As pointed out in the Show Cause Order, Trademark Rule 2.134(b) states that a showing of inadvertence or mistake in failing to file a Section 8 affidavit is good cause for not entering judgment. In fact, inadvertence or mistake is the only basis expressly provided by Rule 2.134 for avoiding a judgment. Registrant's Response clearly indicates that the failure to file the Section 8 affidavit was purposeful and therefore admits there was no inadvertence or mistake. A judgment against Registrant is therefore appropriate.

Other than recklessly attacking Petitioner's "motives," Registrant has provided no basis or justification for a judgment other than one finding that Registrant has abandoned the instant mark in connection with dating services. Accordingly, such judgment should be entered at this time by the Board.

**E. Conclusion**

Registrant admits it has not used the subject mark for more than one year. During that year, Registrant has: (a) misused the subject registration to block Petitioner's own application; (b) falsely denied the allegations of non-use; and (c) wasted the time and resources of the Board, Petitioner and USPTO examiners by maintaining a registration it knows has been abandoned.

The Board should, once and for all, enter a judgment unequivocally stating the obvious, that Registrant has abandoned the **JEWCY** mark with respect to dating services. Such an action is the only way to ensure an end to Registrant's abusive conduct.

Date: May 23, 2014

Respectfully submitted,

**LOTT & FISCHER, PL**

/s/Ury Fischer  
Ury Fischer  
P.O. Drawer 141098  
Coral Gables, FL 33114-1098  
(305) 448-7089

Docket No. 01177-8810

*Attorneys for Petitioner  
Avalanche, LLC*

**CERTIFICATE OF SERVICE**

**I HEREBY CERTIFY** that the foregoing document was filed electronically with the TTAB via ESTTA on May 23, 2014 and that on the same date a true and correct copy of the same was served on counsel for Registrant via first class mail addressed as follows:

Jason M. Vogel  
Kilpatrick Townsend & Stockton LLP  
1114 Avenue of the Americas, 21st Floor  
New York, NY 10036-7703

/s/ Ury Fischer  
Ury Fischer



# **EXHIBIT A**



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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
[www.uspto.gov](http://www.uspto.gov)

## LETTER OF PROTEST MEMORANDUM

DATE: January 15, 2013

TO: Deborah S. Cohn  
Commissioner for Trademarks

FROM: Dawnmarie D. Sanok  
Attorney Advisor  
Office of the Deputy Commissioner  
for Trademark Examination Policy

SUBJECT: Letter of protest filed in reference to U.S. Application Serial No. 76711757 for the mark JEWCIER for providing on-line social networking services by means of a global computer network

I recommend that this letter of protest be accepted and jurisdiction be restored to the examining attorney for further action consistent with the information presented in the letter of protest.

The protestor has presented evidence of a likelihood of confusion with the following registered marks and pending applications.

U.S. Registration No. 3228371 and 2843648 for the mark JEWCY for dating and matchmaking services, in International Class 45, and entertainment, namely live variety, drama and comedy performances featuring live and recorded music, in International Class 41, respectfully; and

U.S. Application Serial Nos. 85976070 and 85235901 for the mark JEWCY and Design for, among other services, online journals in the field of entertainment and religion, religious events including cultural events, and entertainment services namely, live performances by musical bands; presentation of musical performance; provision of information relating to live musical concerts, in International Class 41.

If you agree with my determination, please sign the attached Request for Jurisdiction. If you disagree with my determination, please so indicate and I will issue a denial letter to the protestor.

# **EXHIBIT B**

ESTTA Tracking number: **ESTTA527828**Filing date: **03/20/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	NEXTBOOK, INC.
Granted to Date of previous extension	03/20/2013
Address	37 WEST 28TH STREET 8TH FLOOR New York, NY 10001 UNITED STATES

Attorney information	Jason M. Vogel, Esq. Kilpatrick Townsend & Stockton LLP 1114 Avenue of the Americas, 21st Floor New York, NY 10036 UNITED STATES jvogel@ktslaw.com, agarcia@ktslaw.com, OHarris@ktslaw.com, tadmin@kiltown.com, nytrademarks@kilpatricktownsend.com Phone:212-775-8700
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**Applicant Information**

Application No	76711757	Publication date	11/20/2012
Opposition Filing Date	03/20/2013	Opposition Period Ends	03/20/2013
Applicant	Avalanche, LLC 1691 Michigan Ave., Suite 410 Miami Beach, FL 33139 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 045. First Use: 2010/08/25 First Use In Commerce: 2010/08/25  
All goods and services in the class are opposed, namely: Providing on-line social networking services by means of a global computer network

**Grounds for Opposition**


Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2843648	Application Date	07/24/2002
Registration Date	05/18/2004	Foreign Priority Date	NONE
Word Mark	JEWCY		

Design Mark	<b>JEWCY</b>
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2002/06/00 First Use In Commerce: 2002/06/00 ENTERTAINMENT, NAMELY LIVE VARIETY, DRAMA AND COMEDY PERFORMANCES FEATURING LIVE AND RECORDED MUSIC

U.S. Registration No.	3228371	Application Date	01/02/2003
Registration Date	04/10/2007	Foreign Priority Date	NONE
Word Mark	JEWCY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 045. First use: First Use: 2006/09/15 First Use In Commerce: 2006/09/15 DATING AND MATCHMAKING SERVICES		

U.S. Application No.	85976070	Application Date	06/01/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	JE CY		
Design Mark			
Description of Mark	The mark consists of the letters "J", "E", "C", and "Y" in a stylized format with the Hebrew character Shin in a stylized format between the "JE", and "CY".		
Goods/Services	Class 041. First use: First Use: 2001/11/15 First Use In Commerce: 2002/11/15 On-line journals, namely, blogs featuring information in the field of religious, cultural, arts and educational material; entertainment services, namely, providing a website featuring audio and audiovisual recordings featuring religious material, cultural material, the arts and educational material; providing information in the fields of religious instruction, cultural events, the arts and education via the internet; providing electronic publications in the nature of electronic magazines		

	and online magazines relating to the Jewish culture, music and entertainment; electronic publication services, namely, publication of electronic magazines and online magazines; providing a website featuring entertainment information on musical artists, musical concert tours, events and downloadable and streaming audio and audiovisual musical content; providing entertainment information via the Internet; conducting of ceremonies and events; entertainment services, namely, conducting parties; organizing religious events, namely, religious instruction services, and cultural events; organizing exhibitions and events for educational, religious instruction, cultural, arts and entertainment purposes; production of live entertainment performances and shows; entertainment, namely, live variety, drama and comedy performances featuring live and recorded music; arranging and conducting of concerts and live music events
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Attachments	76433557#TMSN.gif ( 1 page )( bytes ) 85976070#TMSN.jpeg ( 1 page )( bytes ) 2013-3-20 Notice of Opposition (JEWCIER).pdf ( 8 pages )(278383 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Olivia Harris/
Name	Olivia Harris
Date	03/20/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Serial No. 76/711,757

Mark: JEWCIER

Filing Date: June 15, 2012

Publication Date: November 20, 2012

Our Reference No.: 94155/ 811575

NEXTBOOK, INC.,

Opposer,

v.

Opposition No. \_\_\_\_\_

AVALANCHE, LLC,

Applicant.

**NOTICE OF OPPOSITION**

Opposer Nextbook, Inc., a Delaware corporation with an address at 37 West 28th Street, 8th Floor, New York, New York 10001 (“Opposer”), believes that it will be damaged by the registration of the trademark shown in Application Serial No. 76/711,757 (the “Application”) and therefore opposes the same pursuant to 15 U.S.C. § 1063.


As grounds for its opposition, Opposer alleges as follows:

1. Opposer is the owner of the following U.S. trademark registrations for the trademark JEWCY (the “JEWCY Mark”):

Reg. No.	Goods/Services	Reg. Date	Date of First Use
2,843,648	Entertainment, namely live variety, drama and comedy performances featuring live and recorded music (Class 41)	May 18, 2004	June 2002
3,228,371	Dating and matchmaking services (Class 45)	April 10, 2007	September 15, 2006

The foregoing registrations are valid and in full force and effect, and thus constitute *prima facie* evidence of Opposer's exclusive right to use the JEWCY Mark in commerce in connection with the goods and services specified in the registrations.

2. Opposer is also the owner of the following U.S. trademark application for the JEWCY Mark:

Mark	Serial No.	Goods/Services	Filing Date	Date of First Use
JEWCY and Design 	85/976,070	On-line journals, namely, blogs featuring information in the field of religious, cultural, arts and educational material; entertainment services, namely, providing a website featuring audio and audiovisual recordings featuring religious material, cultural material, the arts and educational material; providing information in the fields of religious instruction, cultural events, the arts and education via the internet; providing electronic publications in the nature of electronic magazines and online magazines relating to the Jewish culture, music and entertainment; electronic publication services, namely, publication of electronic magazines and online magazines; providing a website featuring entertainment information on musical artists, musical concert tours, events and downloadable and streaming audio and audiovisual musical content; providing entertainment information via the Internet; conducting of ceremonies and events; entertainment services, namely, conducting parties; organizing religious events, namely, religious instruction services, and cultural events; organizing exhibitions and events for educational, religious instruction, cultural, arts and entertainment purposes; production of live entertainment performances and shows; entertainment, namely, live variety, drama and comedy performances featuring live and recorded music; arranging and conducting of concerts and live music events (Class 41)	June 1, 2010	November 15, 2002



### **Applicant's Application**

3. Notwithstanding Opposer's prior rights in its JEWCY Mark, on June 15, 2012, Avalanche, LLC ("Applicant"), with an address of 1691 Michigan Avenue, Suite 410, Miami Beach, Florida 33139, filed an Application to register the JEWCIER mark ("Applicant's Mark") for "Providing on-line social networking services by means of a global computer network" in International Class 45, claiming a date of first use of August 25, 2010.

4. The Application was published in the *Trademark Official Gazette* on November 20, 2012. On December 13, 2012, Opposer timely filed a request for a ninety (90) day extension of time to oppose the Application, which was granted on December 13, 2012 by the Trademark Trial and Appeal Board through and until March 20, 2013. On December 19, 2012, Opposer filed a Letter of Protest, which was accepted by the Commissioner for Trademarks on January 17, 2013, and jurisdiction of the application was restored to the Examining Attorney. Subsequently, an Office Action was issued on February 28, 2013 refusing registration of the Application under Section 2(d) on the basis of likelihood of confusion with Opposer's prior registrations and prior pending applications for the JEWCY Mark.

5. There is no issue as to priority. Opposer, through its predecessors, began using its JEWCY Mark in commerce at least as early as 2002, well prior to the June 15, 2012 filing date of Applicant's Application, or Applicant's August 25, 2010 claimed date of first use.

6. Applicant's Mark is virtually identical from a visual, phonetic and conceptual perspective to the JEWCY Mark, differing only in the addition of the superlative variant "ier," which does nothing to distinguish Applicant's Mark from the JEWCY Mark. In fact, the addition of the superlative suffix "-ier" falsely suggests that Applicant's services are merely a higher level

of services offered by the same entity as Opposer's services. Moreover, both Applicant's Mark and Opposer's JEWCY Mark utilize the same misspelling of the "jui" prefix in the words "juicy" and "juicier," replacing these letters with the letters "jew." This identical play on words renders the marks connotatively identical in that both make reference to the parties' identical target audience, namely, Jewish consumers.

7. The services listed by Applicant in the Application are identical and/or highly related to the services offered by Opposer under the JEWCY Mark.

8. Accordingly, Applicant's use of Applicant's Mark for the services set forth in the Application is likely to cause consumers to be confused, to be deceived, and to assume erroneously that Applicant's services are those of Opposer, or that Applicant is in some way connected with, sponsored by, or affiliated with Opposer, all in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and with consequent injury to Opposer and the public.

9. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Opposer believes that it will be damaged by registration of Applicant's Mark in that members of the purchasing public are likely to be confused or mistaken that Applicant's services offered under Applicant's Mark originate from Opposer, or from the same source as services offered under Opposer's JEWCY Mark, or that such services of Applicant are sponsored by, endorsed by, or affiliated with the source of services sold under Opposer's JEWCY Mark. Such likelihood of confusion results in damage to the goodwill among purchasers and the trade that is symbolized by Opposer's JEWCY Mark.

10. If Applicant is granted the registration herein opposed, it would thereby obtain a *prima facie* exclusive right to the use of Applicant's Mark. Such registrations would be a source of damage and injury to Opposer.

**WHEREFORE**, Opposer requests that registration of Application Serial No. 76/711,757 be denied pursuant to 15 U.S.C. §§ 1052(d) and 1063(a).

The opposition fee in the amount of \$300.00 for a notice of opposition in one class is filed with this Notice of Opposition. If for any reason this amount is insufficient, it is requested that Kilpatrick Townsend & Stockton LLP's Deposit Account No. 11-0855 be charged with any deficiency. This paper is being filed electronically.

Please recognize Jason Vogel, Olivia Harris, and the law firm of Kilpatrick Townsend & Stockton LLP as attorneys for Opposer in connection with this opposition proceeding. Please address all correspondence regarding this proceeding to Jason Vogel at Kilpatrick Townsend & Stockton LLP, 1114 Avenue of the Americas, New York, New York 10036.

Dated: March 20, 2013

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

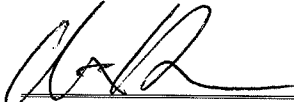
By: 

Jason Vogel  
Olivia Harris  
1114 Avenue of the Americas  
New York, NY 10036  
Telephone: (212) 775-8700  
Facsimile: (212) 775-8800

*Attorneys for Opposer, Nextbook, Inc.*

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION is being filed electronically with the TTAB via ESTTA on this day, March 20, 2013.

  
\_\_\_\_\_  
Olivia Harris  
*Attorney for Opposer*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Serial No. 76/711,757

Mark: JEWCIER

Filing Date: June 15, 2012

Publication Date: November 20, 2012

Our Reference No.: 94155/ 811575

NEXTBOOK, INC.,

Opposer,

v.

AVALANCHE, LLC,

Applicant.

Opposition No. \_\_\_\_\_

**CERTIFICATE OF SERVICE**

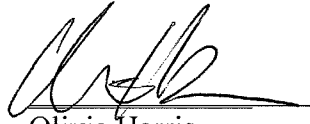
I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION has been served on Applicant and counsel for Applicant by mailing said copies on March 20, 2013, via First Class Mail, postage prepaid, and addressed as follows:

Avalanche, LLC  
1691 Michigan Avenue, Suite 410  
Miami Beach, Florida 33139

Fred D. Zemel  
Scarinci & Hollenbeck  
1100 Valley Brook Avenue, P.O. Box 790  
Lyndhurst, New Jersey 07071-0790

A copy was also sent by electronic mail to the email address for counsel for applicant:

FZemel@scarincihollenbeck.com.



Olivia Harris  
*Attorney for Opposer*